

U.S. Patent Application No. 09/900,684
Attorney Docket No. 13DV13928 (07783-0076)

REMARKS

The Final Office Action mailed December 22, 2005 has been received and carefully considered. As of the Final Office Action, claims 1, 3 and 5-20 were pending. Claims 1, 3, 5-10, and 12-20 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Publication 2003/0140315 to Blumberg, et al. (Blumberg) in view of Official Notice. Claim 11 stands rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of Official Notice and further in view U.S. Patent 6,224,387 to Jones (Jones) and Internet Printing Solutions. Claims 1, 12 and 18 are independent.

I. Amendments to the Claims.

Claims 1, 3, and 5-11 are objected to in light of a grammatical error found in independent claim 1. Applicants thank the Examiner for pointing out this error; claim 1 has been amended to correct the error in a manner that is believed to overcome the objection.

II. Rejection under 35 U.S.C. § 103(a).

Claims 1, 3, 5-10, and 12-20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of Official Notice. Claim 11 stands rejected under 35 U.S.C. §103(a) as unpatentable over Blumberg in view of Official Notice and further in view Jones and Internet Printing Solutions. Applicants respectfully traverse the rejections.

As stated by the Federal Circuit, "a proper analysis under 35 U.S.C. § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success." *In re Paeck*, 947, F.2d 488, 493 (Fed. Cir. 1991). In addition, the prior art reference(s) must teach or

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suggest all of the claim limitations. The teaching or suggestion to combine and the reasonable expectation of success must both be found in the prior art, and not in Applicant's disclosure.

Id at 493. *See also* M.P.E.P. § 2142.

As understood by Applicants, Blumberg is directed to a method for creating and viewing content to be printed, including the steps of receiving an electronic document, selecting finishing options for the document and displaying how the electronic document would look in printed form. After the finishing options of the document are selected, a user may order a prescribed number of copies, the order then being prioritized and routed to a print service provider.

A. Claims 1, 3, 5-10, and 12-20

Claims 1, 12 and 18 are independent. In making the rejections, the Examiner has acknowledged that Blumberg fails to teach several features of the claimed invention. Apparently unable to find any other prior art reference that overcomes these deficiencies, the Examiner primarily relies on Official Notice in rejecting the claims. As a basis for the rejections, the Examiner simply asserts numerous features are "well-known." "Well-known" is not a statutory category of prior art. The MPEP explicitly states that Official Notice is permissible only in very limited circumstances – none of which are present here.

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances...Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03.

Claim 1 includes the limitations (1) an application including means for retrieving status information from the database on a copy reproduction request by a user accessible on a first client computer and (2) a second client computer communicating with the database to access the

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stored information on copy reproduction requests in the database. Similarly, claim 12 also includes the limitation of an application including means for retrieving status information from the database on a copy reproduction request. The Examiner acknowledges Blumberg fails to teach all of these limitations. The Examiner instead relies on Official Notice to conclude that each of these features are individually well known in the art (see Office Action at pgs. 3-5 and 9-11), but without even providing a basis why each of the "well-known" features would also be obvious in combination with one another.

Claims 1 and 12 also each include the limitation of an additional application accessible by a copy reproduction service provider, also acknowledged as not taught by Blumberg. However, the Examiner here further relies on Official Notice, stating that it is "well-known" for other clients to have applications, thus bootstrapping the first instance of Official Notice that a second client computer (acknowledged as not taught by Blumberg) might exist, to then take secondary Official Notice of what applications would be on or accessible by the second client computer not taught by Blumberg.

The Examiner has essentially used Official Notice to construct a non-existent prior art reference out of whole cloth that is now said to teach or suggest all of the limitations of Applicants' claimed invention. Not only is this improper under the Patent Office's strict guidelines for use of Official Notice, but it also fails the axiomatic requirement that the claimed invention must be viewed taken as a whole in light of the prior art. "In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious" to one of ordinary skill in the art at the time the invention was made. MPEP 2142. That is, even if the Examiner had a single, actual prior art reference that taught all that is now said to be officially noticed, without some suggestion to combine the

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teachings of that reference with Blumberg, the Examiner would be doing nothing more than selecting features from a laundry list of known components to re-construct Applicants' claimed invention. Hindsight rationalization in light of the disclosure of the specification being examined is not permitted. MPEP 2143 and 2143.01. It is well established that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP 2142.

Only by looking at Applicants' own disclosure does one find any suggestion to add various features not present in Blumberg that ultimately result in Applicants' claimed invention. As already noted, the added features admitted by the Examiner as not found in Blumberg are not even asserted to be found in another prior art reference, but are merely stated by the Examiner to be "well-known."

Applicants continue to traverse the Examiner's rejection on the basis that the Examiner appears to have incorrectly stated the time at which even properly cited "well-known" elements must be analyzed. Specifically, the Examiner uses the present tense in the Office Action in describing, for example, that "second clients for enabling service providers to access information from their servers *are* well known." Office Action at 5 (emphasis added). Based on this present day analysis of what is now known, the Examiner then concludes that "it would have been obvious to one of ordinary skill in the art of electronic commerce *at the time of applicant's invention...*" *Id.* (emphasis added).

The Examiner's analysis is thus flawed because it uses what is known now as the basis of what was known at the time of filing. "To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." MPEP

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2142. Applicants respectfully submit that one cannot necessarily say that everything the Examiner has alleged is currently well-known in the art was also well known when the Application was filed, now well over four years ago. While the Examiner attempts to convert the rejection into a game of semantics in the Final Action (see page 17), the fact remains that the rejection is legally flawed.

Finally, the Examiner fails to identify any teaching in Blumberg that would provide a motivation to combine any of the "well-known" features with Blumberg. Rather, it appears that because the Examiner takes the position that because the features are alleged to be well-known, it automatically follows that incorporating them into Blumberg is necessarily obvious, even without any motivation in Blumberg that those features be included.

MPEP 2143.01 (IV) is entitled "Fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness"

That section further states

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *AI-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

Despite this clear prohibition, this is exactly what the Examiner has done in the instant case. The Examiner merely states that it would be "advantageous" to combine officially noticed

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facts with the teachings of Blumberg to arrive at Applicants' claimed invention. This is per se hindsight reconstruction and is insufficient to establish a prima facie case of obviousness.

For at least these reasons, claims 1 and 12 are believed to be allowable and the rejection should be withdrawn.

The problems with the Examiner's Official Notice arguments are further illustrated by looking more closely at the claims which depend from claims 1 and 12. By way of example only, with respect to claim 5, the Examiner admits that "Blumberg does not disclose an additional server computer connected to the second client computer (which the Examiner has already admitted is not taught by Blumberg), the additional server computer comprising a storage device to store the additional application for processing copy reproduction requests." With respect to claim 6 – which depends from claim 5 - the Examiner admits that "Blumberg does not disclose means for a copy reproduction service provider to provide authentication information to access the additional application for processing copy reproduction requests stored on the additional server computer." Thus, it is apparent that the Examiner admits that Blumberg fails to teach several other limitations of Applicants' claimed invention as found in the dependent claims. With respect to claim 6, for example, counting up all of the features that the Examiner admits are not taught by Blumberg shows that no less than *five* elements of that claim are admittedly not taught by the prior art of record.

For the same reasons as already discussed in more detail above that, absent reference to Applicants' own patent application, one would not arrive at the broader independent claims 1 and 12, even more unlikely is that one of ordinary skill in the art would continue to combine still more "well-known" features to eventually arrive at Applicants' claimed invention as found in each of the dependent claims. That is, even assuming, *arguendo*, each of the elements asserted

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to be "well-known" were just that, the specific arrangement of all of those "well-known" features exactly as found in Applicants' claimed invention does not automatically follow, unless one impermissibly uses the Application as a starting point and works backwards.

Likewise, the Explanation of Rejection for each of dependent claims 7, 8, 9, 10, 14, 15, 16 and 17 also begins with an admission by the Examiner that Blumberg fails to teach the limitations of these claims, followed only by an assertion of Official Notice that the limitations discussed in each claim are "well-known."

With respect to claim 18, it includes the limitation "changing the order request, by a user, including updating the status information in the database for a copy reproduction request." As discussed in the Specification, one feature of Applicants' claimed invention is the ability of the user to update the status, for example, by updating the status to "cancelled." See Application at ¶ [0034], which feature is not taught or suggested by Blumberg.

For at least these reasons, claim 18 is believed to be allowable and the rejection should be withdrawn.

Claims 3, 5-10, 13-17 and 19-20 all depend from claims 1, 12 and 18. Thus, all of these claims are also believed to be allowable and the rejection should be withdrawn.

B. Claim 11

Claim 11 depends from claim 1. Jones and Internet Printing Solutions are believed to be cited by the Examiner only for their teaching of various forms of document reproduction and both fail to overcome the deficiencies of Blumberg. Furthermore, Blumberg is specifically directed to displaying a document electronically as it would appear in printed form. Blumberg, Abstract. Thus, there would be no motivation to reproduce the electronic documents of Blumberg on a CD-ROM, since the whole point of Blumberg is to help visualize how the

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document will look once it is finally printed out, which would be of little use to a document that was to be reproduced in electronic form. As a result, claim 11 is also believed to be allowable for at least the same reasons as already presented and this rejection should also be withdrawn.

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CONCLUSION

For at least the foregoing reasons, Applicants respectfully request reconsideration of the Application and withdrawal of the outstanding rejections. Applicants respectfully submit that each of pending claims 1, 3, and 5-20 is not rendered obvious by Blumberg, alone or in combination with Jones and Internet Printing Solutions, and thus, all are in condition for allowance. Applicants request allowance of all pending claims in a timely manner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicants' undersigned representative.

Applicants believe that the Examiner's rejections constitute clear error. In the event that the Application is not allowed in response to this Paper, Applicants are separately filing on this same date a Notice of Appeal and Request for Pre-Appeal Brief Review.

This Response has been filed within three months of the mailing date of the Office Action and it is believed that no fees are due with the filing of this paper. In the event that Applicants are mistaken in their calculations, the Commissioner is authorized to deduct any fees determined by the Patent Office to be due from the undersigned's Deposit Account No. 50-1059.

Date: March 22, 2006

Respectfully submitted,

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